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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/849,637

05/04/2001

Dov Malonek

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07/31/2006

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EXAMINER

EVANISKO, GEORGE ROBERT

ART UNIT

PAPER NUMBER

3762

DATE MAILED: 07/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

JP

**Office Action Summary**

Application No.

09/849,637

Applicant(s)

MALONEK ET AL.

Examiner

George R. Evanisko

Art Unit

3762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 May 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-33, 36-48, 50-61 and 63-94 is/are pending in the application.
- 4a) Of the above claim(s) See Continuation Sheet is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19, 41-44, 45/(19 and 41-44) and 74-94 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Continuation of Disposition of Claims: Claims withdrawn from consideration are 5-18, 20-33, 36-40, 45/(5-18, 20-33, 36-40), 46-48 and 50-61 and 63-73 .

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/30/06 has been entered.

### ***Response to Amendment***

The declaration under 37 CFR 1.132 filed 5/30/06 is insufficient to overcome the rejection of the claims based upon the 112 first paragraph rejection as set forth in the last Office action because: the declaration does not contain a statement by the declarant on the same document that warned that willful false statements and the like are punishable by fine or imprisonment, or both (18 U.S.C. 1001) and may jeopardize the validity of the application or any patent issuing thereon. The declarant must set forth in the body of the declaration that all statements made of the declarant's own knowledge are true and that all statements made on information and belief are believed to be true. Please see 37 CFR 1.68 and MPEP 715.04.

The specification does not describe any facts on how to make or enable one skilled in the art to make an electrode with a capacitance of 300-3000 microfarads except to list several materials used for the electrode, such as platinum iridium (page 8), briefly states that porous materials increase the capacitance and minimize impedance (page 22), and discloses that a capacitance of 300-3000 microfarads is used (page 20). As seen in the 112 first paragraph rejection set forth in this action or the previous action, several questions arise as to how to make

an electrode with a capacitance of 300-3000 microfarads. In addition, the declaration shows in paragraphs 31-41 that numerous technical steps are needed to make an electrode which has a capacitance of 300-3000 microfarads.

Finally, according to MPEP 716.09, “[A]ffidavits or declarations presented to show that the disclosure of an application is sufficient to one skilled in the art are not acceptable to establish facts which the specification itself should recite. In re Buchner, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991) (Expert described how he would construct elements necessary to the claimed invention whose construction was not described in the application or the prior art; this was not sufficient to demonstrate that such construction was well-known to those of ordinary skill in the art.); In re Smyth, 189 F.2d 982, 90 USPQ 106 (CCPA 1951).

#### ***Election/Restrictions***

Claims 46-48 and 50-61 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 3/26/03.

Claims 5-18, 20-33, 36-40, 45/(5-18, 20-33, 36-40), and 63-73 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made by election by original presentation in the office action dated 12/10/04 and **without** traverse in the reply filed on 6/10/05.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

Art Unit: 3762

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19, 41-44, 45/(19 and 41-44) and 74-94 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The subject matter not disclosed is how to make a unitary/signal delivery electrode having a capacitance greater than 300 microfarads and less than 3000 microfarads, in combination with the other elements in the claim. The specification lists several materials used for the electrode (page 8), such as platinum iridium, briefly states that porous materials increase the capacitance and minimize impedance (page 22), and discloses that a capacitance of 300-3000 microfarads is used (page 20). But, the specification is silent as to how the delivery electrode is made to have a 300-3000 microfarad capacitance. Several questions arise as to how to make the electrode have a capacitance of 300-3000 microfarads, such as: How is the porousness changed? Is it increased or decreased for the unitary/signal electrode? How is the porousness changed for each of the different electrode materials? How does it affect the capacitance? How does the length, electrode material, thickness of electrode material, etc. affect the capacitance (and in combination with the porousness)?

In addition, one skilled in the art could not practice/make the invention without undue experimentation to arrive at an electrode with a capacitance of 300-3000 microfarads. Several factors have been considered to arrive at this conclusion, such as:

The amount of direction provided by the applicant is minimal. Several common/conventional electrode materials are listed in the specification (page 8), but only a brief mention is made that porous materials increase the capacitance (page 22).

As stated above, several questions arise as to how to make the electrode and therefore undue experimentation would be necessary.

The applicant has provided no working examples in the specification.

The state of the prior art is silent as to how to make an electrode with a capacitance of 300-3000 microfarads (and using porousness and/or the specific electrode materials). The examiner has provided a recent patent (Ekwall) showing the use of electrode thickness, not porousness, to change the capacitance, but the capacitance is only changed to 1-15 microfarads. In addition, the applicant argues on page 16 of the reply dated 6/10/05 that the same materials used by applicant (titanium nitride, iridium oxide) at most have a capacitance of 150 microfarads, and therefore more guidance on how to make the electrode is needed.

Finally, the claims are very broad (a common electrode and connector) and only really have a limitation directed to the electrode having a 300-3000 microfarad capacitance. Therefore, more guidance than "porous materials increases the capacitance" is needed.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 19, 41-44, 45/(19 and 41-44) and 74-94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 43, "said at least one sensing electrode" lacks antecedent basis.

In claim 86, the claim is incomplete for omitting essential structural relationship to any other element in claim 86. The claim needs to connect the sensing electrode to another element and needs to use "further comprising" in line 1. In addition, the "connection means" used in claim 86 is vague since it can not be determined if this is the same connection means used in claim 83 or a different means.

### ***Response to Arguments***

Applicant's arguments filed 5/30/06 have been fully considered but they are not persuasive. It is noted that the declaration is not effective due to several reasons listed above. It is noted that the arguments of counsel cannot take the place of evidence in the record. In re Schulze, 346 F.2d 600, 602, 145 USPQ 716, 718 (CCPA 1965). MPEP 716.01(c).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to George R. Evanisko whose telephone number is 571 272 4945. The examiner can normally be reached on M-F 6:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Angela Sykes can be reached on 571 272 4955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3762

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

George R Evanisko  
Primary Examiner  
Art Unit 3762

7/21/6

GRE  
July 21, 2006